

Application Serial No. 10/717,912

REMARKS

In the Office Action, the Examiner noted that claims 1-26 were pending in the application, that claims 1-6, 8-10 and 12-26 are rejected, and that claims 7 and 11 are objected to. The Examiner indicated that claims 7 and 11 would be allowable if rewritten in independent form to include all the limitations of the base claim.

By this Amendment, claims 1, 7, 10, 12, 15, 21 and 24 have been amended. Thus, claims 1-26 are pending in the application. The Examiner's rejections are traversed below.

Rejections under 35 U.S.C. §102 and §103

Claims 1-6, 8-10 and 12-26 are rejected under 35 U.S.C. §102(b) and §103 as being unpatentable over Lemmen, U.S. Patent 4,774,966, alone or in combination with Koch, U.S. Patent 3,897,058 and Fry-Welch et al., U.S. Patent 5,163,443. Applicant respectfully traverses this rejection.

Neither Lemmen nor Koch relate at all to the present invention where the hand is secured in a substantially fixed position as part of the measuring of the muscle strength of the human thumb. For example, Lemmen merely recites that the hand is positioned on the device. (Lemmen, col. 3, lines 55-65). Koch and Fry-Welch et al. similarly do not include the combination of features recited in each of the independent claims. For example, Koch discloses the use of a device for the swinging of a golf club. Fry-Welch et al. discloses a system for testing hand, wrist and forearm strength and is unrelated to a system for measuring the strength of the thumb. Further, the structure of Fry-Welch et al. is significantly different from the present invention.

Accordingly, Applicant respectfully submits that the presently claimed invention patently distinguishes over Lemmen, alone or in combination with Fry-Welch et al. and/or Koch.

In addition, the present invention provides benefits which are not able to be provided by the prior art alone or in combination. Specifically, the inventor of the present application has utilized the present invention in a substantial number of trials and

Application Serial No. 10/717,912

has published the following research information showing patterns of muscle strength in the thumb over a variety of variables that heretofore has never been able to have been compiled, a copy of which is attached hereto. Accordingly, for these reasons as well, Applicant respectfully submits that the presently claimed invention in each of claims 1-6, 8-10 and 12-26 are patentable over the prior art.

Further, Applicant also submits that the Examiner has not provided any motivation to have provided a combination of prior art references as proposed by the Examiner.

Finally, the Examiner has indicated that claim 11 would be allowable if rewritten in independent form. Applicant advises that claim 11 is an independent claim, and considers the Examiner's indication that claim 11 is in fact allowed for the prior art of record.

Accordingly, Applicant respectfully submits that claims 1-26 are patentable over the prior art asserted by the Examiner. Withdrawal of this rejection is respectfully requested.

Application Serial No. 10/717,912

CONCLUSION

Applicant respectfully submits that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicant does not concede that the cited prior art shows any of the elements recited in the claims. However, Applicant has provided specific examples of elements in the claims that are clearly not present in the cited prior art.

Applicant strongly emphasizes that one reviewing the prosecution history should not interpret any of the examples Applicant has described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicant asserts that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicant has emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, Applicant does not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicant is providing examples of why the claims described above are distinguishable over the cited prior art.

Applicant wishes to clarify for the record, if necessary, that the claims have been amended to expedite prosecution. Moreover, Applicant reserves the right to pursue the original subject matter recited in the present claims in a continuation application.

Any narrowing amendments made to the claims in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather merely Applicant's best attempt at providing one or more definitions of what the Applicant believes to be suitable patent protection. In addition, the present claims provide the intended scope of protection that Applicant is seeking for this application. Therefore, no estoppel should be presumed, and Applicant's claims are intended to include a scope of protection under the Doctrine of Equivalents.

Further, Applicant hereby retracts any arguments and/or statements made during prosecution that were rejected by the Examiner during prosecution and/or that were unnecessary to obtain allowance, and only maintains the arguments that persuaded the Examiner with respect to the allowability of the patent claims, as one of ordinary skill would understand from a review of the prosecution history. That is, Applicant

Application Serial No. 10/717,912

specifically retracts statements that one of ordinary skill would recognize from reading the file history were not necessary, not used and/or were rejected by the Examiner in allowing the patent application.

For all the reasons advanced above, Applicant respectfully submits that the rejections have been overcome and should be withdrawn.

For all the reasons advanced above, Applicant respectfully submits that the Application is in condition for allowance, and that such action is earnestly solicited.

Application Serial No. 10/717,912

BEST AVAILABLE COPY

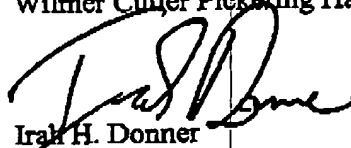
AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment to Deposit Account No. 08-0219

In the event that an Extension of Time is required, or which may be required in addition to that requested in a petition for an Extension of Time, the Commissioner is requested to grant a petition for that Extension of Time which is required to make this response timely and is hereby authorized to charge any fee for such an Extension of Time or credit any overpayment for an Extension of Time to Deposit Account No. 08-0219.

Respectfully submitted,

Wilmer Cutler Pickering Hale and Dorr LLP


Ira H. Donner
Registration No. 35,120

399 Park Avenue
New York, NY 10022
TEL (212) 230-8887
FAX (212) 230-8888

Date: 2/28/05

IHD:tes